

Remarks

Claims 1-13 are pending in the subject application and are presented to the Examiner for further review. Favorable consideration of these claims, in view of the remarks set forth herein, is earnestly solicited.

Claims 1-13 have been rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over RO-115,885 (hereinafter the RO '885 reference). The applicants respectfully traverse this ground for rejection because the cited reference does not disclose or suggest the applicants' advantageous method for preparing a metal salt of a medium chain fatty acid.

The RO '885 reference describes a process whereby a mixture of medium-chain length triglycerides (not fatty acids) and/or long-chain length triglycerides present in animal fats or vegetable oils is first subjected to methanolysis by treatment with a metal hydroxide in methanol and then saponified (after separation of the glycerol by-product) by treatment with more metal hydroxide in water/alcohol.

The present invention, as set forth in claim 1, is a process whereby a medium-chain length fatty acid is neutralized by treatment with a metal bicarbonate or metal carbonate. This gives a medium-chain length fatty acid salt.

It is a basic premise of patent law that, in order to anticipate, a single prior art reference must disclose within its four corners, each and every element of the claimed invention. In *Lindemann v. American Hoist and Derrick Co.*, 221 USPQ 481 (Fed. Cir. 1984), the court stated:

Anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim. *Connell v. Sears Roebuck and Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983); *SSIH Equip. S.A. v. USITC*, 718 F.2d 365, 216 USPQ 678 (Fed. Cir. 1983). In deciding the issue of anticipation, the [examiner] must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference. *SSIH, supra*; *Kalman [v. Kimberly-Clarke]*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983)] (emphasis added). 221 USPQ at 485.

The process of the subject invention is readily distinguishable from the process described in the RO '885 reference. The two processes use different chemistry, including beginning with different starting materials. The cited reference describes a methanolysis reaction followed by a saponification reaction whereas the present application describes a simpler, more practical acid-base neutralization reaction.

Furthermore, the two processes use different starting materials. The RO '885 reference uses animal fats or vegetable oils with triglycerides of variable composition and fatty acyl chain-length whereas the present application uses a free fatty acid.

The statement in the outstanding Office Action that "the triglycerides taught [in RO '885] contain the recited fatty acid within its structure" is not correct. The starting material is a triglyceride, not a "free fatty acid," as is required by claim 1. Thus, the starting materials are different, even if, within its structure, the triglyceride contains a series of atoms which, if they were not part of the triglyceride, would resemble a fatty acid. To suggest that these starting materials (triglycerides and fatty acids) are the same would be equivalent to saying that water (H₂O) and hydrogen (H₂) are the same because they both "contain" H₂.

The applicants respectfully point out that for a claim to be anticipated under the principles of inherency, the subject of a single prior art reference must necessarily function in accordance with the limitations of the process or method claimed. *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). Further,

the doctrine of inherency is available only when the prior inherent event can be established as a certainly. That an event may result from a given set of circumstances is not sufficient to establish anticipation. . . . A prior inherent event cannot be established based on speculation, or where a doubt exists (emphasis added). *Ethyl Molded Product Co. v. Betts Package Inc.*, 9 USPQ 2d 1001, 1032-33 (E.D. KY 1988).

As discussed above, the cited reference does not disclose, either explicitly or inherently, the specific process claimed by the current applicants. Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §102(b) based on the RO '885 reference.

The applicants further submit that the RO '885 patent contains no teaching that would lead a person skilled in the art to the applicants' advantageous method.

It is well established in the patent law that the mere fact that the purported prior art could have been modified or applied in some manner to yield an applicant's invention does not make the modification or application obvious unless "there was an apparent reason to combine the known elements in the fashion claimed" by the applicant. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ____ (2007).

As discussed in detail above, the RO '885 patent does not suggest the applicants' unique and advantageous process for the manufacture of specific, desired medium-chain fatty acid salts.

The processes use different chemistries with different starting materials to achieve different results. There would be no reason for the skilled artisan to modify the process of the RO '885 patent to arrive at the currently-claimed advantageous procedure. Nor would there be any expectation of success.

The RO '885 does not disclose or suggest the advantageous process claimed by the current applicants. Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §103 based on the RO '885 reference.

In view of the foregoing remarks and the amendments to the claims, the applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

The applicants invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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